



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,382	11/08/2001	Mitsuteru Oshima	001309.00017	5134
22907	7590	02/04/2005	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			ISMAIL, SHAWKI SAIF	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/986,382

Applicant(s)

OSHIMA, MITSUTERU

Examiner

Shawki S Ismail

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11-08-2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 6,9 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

1. Claims 1-14 are presented for examination.

Applicant's claim for foreign priority is acknowledged.

### ***Claim Objections***

2. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

Claim 6 objected to because of the following informalities: claim 6 states "...transmitted the telephone dial signal upon receipt of the telephone dial signal by the telephone dial signal...". Examiner believes that the phrase "receiving means" should follow the second telephone dial signal. Appropriate correction is required.

Claims 9 states "...provided in an information providing apparatus as recited in claim 1 or a URL of a web page carrying information..." it seems as if the claim is dependent on either 1 or the URL of a web page, however a dependent claim can only depend on a previous independent claim. Appropriate correction is required.

Claims 14 states "...provided in an information providing apparatus as recited in claim 4 or a URL of a web page carrying information..." it seems as if the claim is

Art Unit: 2155

dependent on either 4 or the URL of a web page, however, a dependent claim can only depend on a previous independent claim. Appropriate correction is required.

### **Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 10-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For a subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea of mathematical algorithm in the technological art. However the "recording medium" recited in the claims are not computer readable. The claims have not been clearly tied to a technological art, environment or machine, which would result in a practical application.

### **Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2155

Claims 1, 2 recites" ... the information to be provided by the information providing service is identified or given a telephone call to a telephone number..." it is unclear what how the information to be provided can be given a telephone call.

Claims 7, 8 and 9 depend from a rejected claim; therefore, they are rejected under the same rationale.

### ***Claim Rejections - 35 USC §102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by **Waites** U.S. Patent No. **6,788,769**.

8. As to claims 1, 5 and 10, Waites teaches an information providing apparatus for providing an information receiver with an information providing service, comprising:

information accumulating means for accumulating information to be provided (see Fig. 1, Fig. 2, Fig. 3, Fig. 4, Fig. 5; server 102 accumulates information about the user, such as their telephone number including area code; server 102 also accumulates message voicemail messages that a second user may want to send to a first user as an e-mail message; col. 5, lines 54-65; col. 10, lines 50-65);

Art Unit: 2155

electronic mail receiving means for receiving an electronic mail (see Fig. 3, col. 7, lines 29-43); and

information providing control means for extracting desired information from the information accumulating means to start the information providing service for the information receiver having transmitted an electronic mail to an electronic mail address by which the information to be provided by the information providing service is identified or given a telephone call to a telephone number by which the information to be provided by the information providing service is identified upon receipt of the electronic mail by the electronic mail receiving means (see Fig. 1, Fig. 2, Fig. 3, Fig. 4, Fig. 5; server 102 extracts information about the user, such as their telephone number including area code; server 102 also extracts message voicemail messages that a second user may want to send to a first user as an e-mail message; col. 5, lines 54-65; col. 10, lines 50-65).

9. As to claims 2 and 11, Waites teaches an information providing apparatus for providing an information receiver with an information providing service, comprising:

access means for accessing information on a web page located at a URL transmitted from an information provider (see Fig. 2, col. 6, lines 46-65);

electronic mail receiving means for receiving an electronic mail (see Fig. 5, col. 10, line 66 – col. 11, line 6); and

information providing control means for obtaining the information accessed by the access means to start the information providing service for the information receiver having transmitted an electronic mail to an electronic mail address by which the

Art Unit: 2155

information to be provided by the information providing service is identified or given a telephone call to a telephone number by which the information to be provided by the information providing service is identified upon receipt of the electronic mail by the electronic mail receiving means (see Fig. 1, Fig. 2, Fig. 3, Fig. 4, Fig. 5; server 102 extracts information about the user, such as their telephone number including area code; server 102 also extracts message voicemail messages that a second user may want to send to a first user as an e-mail message; col. 5, lines 54-65; col. 10, lines 50-65).

10. Claims 3 and 12 contain similar limitations as in claim 1; therefore, they are rejected under the same rationale.

11. As to claim 4, 6, and 13, Waites teaches an information providing apparatus for providing an information receiver with an information providing service, comprising:

information accumulating means for accumulating information to be provided (see Fig. 1, Fig. 2, Fig. 3, Fig. 4, Fig. 5; server 102 accumulates information about the user, such as their telephone number including area code; server 102 also accumulates message voicemail messages that a second user may want to send to a first user as an e-mail message; col. 5, lines 54-65; col. 10, lines 50-65);

telephone dial signal receiving means for receiving a telephone dial signal (see Fig. 4, Fig. 5; col. 8, lines 40-54); and

information providing control means for extracting desired information from the information accumulating means to start the information providing service for the information receiver having transmitted the telephone dial signal upon receipt of the

Art Unit: 2155

telephone dial signal by the telephone dial signal receiving means (see Fig. 1, Fig. 2, Fig. 3, Fig. 4, Fig. 5; server 102 extracts information about the user, such as their telephone number including area code; server 102 also extracts message voicemail messages that a second user may want to send to a first user as an e-mail message; col. 5, lines 54-65; col. 10, lines 50-65).

12. As to claim 7, Waites teaches an information processing apparatus comprising electronic mail transmitting means for allowing an information receiver to transmit an electronic mail to electronic mail receiving means provided in an information providing apparatus as recited in claim 1 (see Fig. 1, Fig. 2, Fig. 3, Fig. 4, Fig. 5; server 102 extracts information about the user, such as their telephone number including area code; server 102 also extracts message voicemail messages that a second user may want to send to a first user as an e-mail message; col. 5, lines 54-65; col. 10, lines 50-65).

13. As to claim 8, Waites teaches an information processing apparatus comprising telephone dial signal transmitting means for allowing an information receiver to transmit a telephone dial signal to telephone dial signal receiving means provided in an information providing apparatus as recited in claim 2 (see Fig. 4, Fig. 5; col. 8, lines 40-54).

14. As to claim 9, Waites teaches an information processing apparatus comprising information transmitting means which transmits information to be accumulated by information accumulating means provided in an information providing apparatus as



Art Unit: 2155

recited in claim 1 or a URL of a web page carrying information desired to be provided by the information providing service (see Fig. 2, col. 6, lines 46-65).

15. As to claim 14, Waites teaches an information processing apparatus comprising information transmitting means which transmits information to be accumulated by information accumulating means provided in an information providing apparatus as recited in claim 4 or a URL of a web page carrying information desired to be provided by the information providing service (see Fig. 2, col. 6, lines 46-65).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawki S Ismail whose telephone number is 571-272-3985. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/986,382

Page 9

Art Unit: 2155

Shawki Ismail  
Patent Examiner  
January 31, 2005



HOSAIN ALAM  
SUPERVISORY PATENT EXAMINER